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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,296	10/22/2001	Koji Uchiyama	MC-3	3836

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Daniel R. Brown
P.O. Box 821130
Fort Worth, TX 76182-1130

EXAMINER

PHAM, TUAN

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,296

Applicant(s)

UCHIYAMA, KOJI

Examiner

TUAN A PHAM

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/22/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No.

6,766,175. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-12 in the constant application have the same scope of claimed invention with obvious wording variations. The above patent includes a docking station, cordless telephone, and wireless telephone, which are integrating into docking station for communicating between cordless and wireless telephone via a landline telephone.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson (U.S. Patent No.: 5,915,224) in view of Torrey et al. (U.S. Patent No.: 6,466,799, hereinafter, "Torrey").

Regarding claim 1, Jonsson teaches a telephone docking station (i.e., multi network terminal) for coupling signals among a wireless telephone, a cordless telephone handset and a metallic telephone line (see figure 6), comprising:

a wireless telephone interface (i.e., first function block) adapted to receive the wireless telephone and to couple wireless signals with a first port on the switch, the wireless telephone interface having an output state indicative of the presence of the wireless telephone (see figure 2, switch 12, figure 4, block 30, col.44-67, col.9, ln.1-24);

a cordless telephone base unit having a radio transceiver adapted to communicate with the cordless telephone handset and adapted to couple cordless signals with a second port on the switch (see figure 2, switch 12, figure 6, cordless base 40, transceiver 44, col.10, ln.36-63).

It should be noticed that Jonsson fails to clearly teach a multiple port telephone switch, a telephone line interface adapted to interface with the metallic telephone line and to couple line signals with a third port on the switch, and a controller (i.e., call

processor) coupled to the output, and coupled to control the switch to connect the first port or the second port to the third port as a function of the state of the output.

However, Torrey teaches such features (see figure 2A, multiple ports 226, 227, telephone line interface 298, call processor 223, switching device 225, col.4, ln.54-67, col.5, ln.1-33) for a purpose of detecting the outgoing and incoming calls.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a multiple port telephone switch, a telephone line interface adapted to interface with the metallic telephone line and to couple line signals with a third port on the switch, and a controller (i.e., call processor) coupled to the output, and coupled to control the switch to connect the first port or the second port to the third port as a function of the state of the output, as taught by Torrey, into view of Jonsson in order to save cost and space for integrating the cordless and wireless telephone within a single device.

Regarding claim 2, Jonsson further teaches the apparatus wherein the controller controls the switch to connect the first port to the second port if the output state indicates that the wireless telephone is present, or, the controller controls the switch to connect the third port to the second port if the output state indicates that the wireless telephone is not present (see col.6, ln.25-58, col.9, ln.1-23).

Regarding claim 3, Jonsson further teaches the apparatus further comprising: an actuator (i.e., keypad) coupled to the controller (i.e., decoder), and wherein the controller controls the switch to connect either of the first port or the third port to the second the in accordance with actuation of the actuator (see figure 14, col.14, ln.1-39).

Regarding claim 5, Jonsson further teaches the apparatus further comprising: a cordless handset operable to communicate data signals with the cordless telephone base unit, the cordless handset having an actuator and operable to encode a control signal in the data signals in response to actuation of the actuator, and wherein the radio transceiver is coupled to receive the control signal from the cordless handset and operable to communicate said control signal to the controller, and wherein the controller controls the switch to connect either of the first port or the third port to the second port in accordance with the control signal (see figure 4, figure 6, figure 14, col.9, ln.1-23, col.14, ln.1-39).

Regarding claim 8, Jonsson further teaches a second actuator (e.g., inherently the cordless handset should comprise a keypad) disposed upon said cordless handset for answering an incoming call, and wherein actuation of said second actuator causes said cordless handset to communicate a answer signal to said cordless telephone base unit that couples said answer signal to said controller, and wherein said controller is operable to cause said multiple port switch to coupled to presently ringing one of said wireless telephone interface or said telephone line interface to said second port in response to said answer signal (see col.8, ln.44-67).

5. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson (U.S. Patent No.: 5,915,224) in view of Torrey et al. (U.S. Patent No.: 6,466,799, hereinafter, "Torrey") as applied to claim 1 above, and further in view of Hirai (U.S. Patent No.: 5,309,502).

Regarding claims 4 and 6, Jonsson and Torrey, in combination, fails to clearly teaches a display indicator for indicating which of the ports are connected in the switch, and wherein the controller is coupled to drive the display indicator in accordance with the current connection state of the switch. However, Hirai teaches such features (see figure 1, indicator 27, switch 26, col.6, ln.34-66) for a purpose of selecting different mode.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a display indicator for indicating which of the ports are connected in the switch, and wherein the controller is coupled to drive the display indicator in accordance with the current connection state of the switch, as taught by Hirai, into view of Jonsson and Torrey in order to easily recognize which device is being used.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson (U.S. Patent No.: 5,915,224) in view of Torrey et al. (U.S. Patent No.: 6,466,799, hereinafter, "Torrey") as applied to claim 1 above, and further in view of Dimenstein et al. (Pub. No.: U.S. 2002/0086703, hereinafter, "Dimenstein").

Regarding claim 7, Jonsson and Torrey, in combination, fails to clearly teaches a display disposed within said cordless handset having a Caller ID display portion and a call indicator for indicating the source of a telephone call, and wherein said controller is operable to receive Caller ID data from either of said wireless telephone interface adapter or said telephone line interface, and operable to couple said Caller ID data

together with data indicative of the source of said Caller ID data to said cordless telephone base unit for communications thereof to said cordless handset for display of said Caller ID data on said display and for activation of said call indicator indicative of the source of said Caller ID data. However, Dimenstein teaches such features (see col.2, [0026-0027], Dimenstein does not disclose the controller in his docking station apparatus, However, the docking station are well known to include a CPU or micro controller or processor to control all the elements in the device. Therefore, it would have been obvious to incorporate such a controller within Dimenstein's device) for a purpose of displaying the telephone number.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a display disposed within said cordless handset having a Caller ID display portion and a call indicator for indicating the source of a telephone call, and wherein said controller is operable to receive Caller ID data from either of said wireless telephone interface adapter or said telephone line interface, and operable to couple said Caller ID data together with data indicative of the source of said Caller ID data to said cordless telephone base unit for communications thereof to said cordless handset for display of said Caller ID data on said display and for activation of said call indicator indicative of the source of said Caller ID data, as taught by Dimenstein, into view of Jonsson and Torrey in order to easily recognize who is calling.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson (U.S. Patent No.: 5,915,224) in view of Torrey et al. (U.S. Patent No.: 6,466,799, hereinafter, "Torrey") as applied to claim 1 above, and further in view of Karpus et al. (U.S. Patent No.: 5,884,191, hereinafter, "Karpus").

Regarding claim 9, Jonsson and Torrey, in combination, fails to clearly teaches a speakerphone adapted to couple speakerphone signals with a fourth port on said switch; an actuator coupled to said controller for selecting a speakerphone function, and wherein selection of said speakerphone function causes said controller to control said switch to connect said fourth port in place of said second port, thereby connecting the presently connected one of said wireless signals or said line signals to said speakerphone signals. However, Karpus teaches such features (see figure 2, control switch 310, speakerphone 170, col.3, ln.42-67) for a purpose of hands-free operation.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of a speakerphone adapted to couple speakerphone signals with a fourth port on said switch; an actuator coupled to said controller for selecting a speakerphone function, and wherein selection of said speakerphone function causes said controller to control said switch to connect said fourth port in place of said second port, thereby connecting the presently connected one of said wireless signals or said line signals to said speakerphone signals, as taught by Karpus, into view of Jonsson and Torrey in order to allow for hands-free operation.

8. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonsson (U.S. Patent No.: 5,915,224) in view of Torrey et al. (U.S. Patent No.: 6,466,799, hereinafter, "Torrey") as applied to claim 1 above, and further in view of Lilja et al. (U.S. Patent No.: 5,991,640, hereinafter, "Lilja").

Regarding claim 10, Jonsson and Torrey, in combination, fails to clearly teaches an answering machine adapted to couple answering machine signals with a fourth port on said switch, and wherein said controller is operable to control said switch to connect either of said first port or said third port to said fourth port upon receipt of an answering machine command identifying which of said first of third ports are to be coupled to said fourth port. However, Lilja teaches such features (see figure 3, figure 4, col.2, ln.15-28, col.3, ln.30-67) for a purpose of answering the incoming call.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of an answering machine adapted to couple answering machine signals with a fourth port on said switch, and wherein said controller is operable to control said switch to connect either of said first port or said third port to said fourth port upon receipt of an answering machine command identifying which of said first of third ports are to be coupled to said fourth port, as taught by Lilja, into view of Jonsson and Torrey in order to answer the incoming calls.

Regarding claim 11, Lilja further teaches controller is operable to produce said answering machine command indicating that said first port is to be coupled to said fourth port if said cordless telephone base unit is presently engaged in a telephone call (see col.2, ln.15-28, col.3, ln.40-50, col.4, ln.48-65).

Regarding claim 12, Lilja further teaches controller is operable to produce said answering machine command indicating that said third port is to be coupled to said fourth port if said wireless telephone interface is presently engaged in a telephone call (see col.2, ln.15-28, col.3, ln.40-50, col.4, ln.48-65).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In order to expedite the prosecution of this application, the applicants are also requested to consider the following references. Although Maurer et al. (U.S. Patent No. 5,048,076), Lorenz et al. (U.S. Patent No. 5,151,972), Weinstein et al. (U.S. Patent No. 6,650,635), and Fan (U.S. Patent No. 6,636,506) are not applied into this Office Action; they are also called to Applicants attention. They may be used in future Office Action(s). These references are also concerned for supporting the system and method for providing data and voice services on the telephone line by teaching an interface device having XDSL splitter in the central office.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan A. Pham** whose telephone number is (703) 305-4987. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz can be reached on (703) 305-4708 and

Art Unit: 2643

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Art Unit 2643
October 3, 2004
Examiner

Tuan Pham


CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600